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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,139	02/23/2004	Michael Andrew Egan	10476US10	8159

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EXAMINER

GELLNER, JEFFREY L

ART UNIT PAPER NUMBER

3643

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,139

Applicant(s)

EGAN, MICHAEL ANDREW

Examiner

Jeffrey L. Gellner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 9 of U.S. Patent No. 5,651,213 in view of Buller (GB 2200828 A).

US 5,651,213 discloses a transportable turf comprising a soil-less sand based root zone mixture with 60% sand having a size of 0.05 to 1 mm, an organic amendment of sphagnum peat moss, grain size of from 0.18 to 0.84 mm, fertilizer. Not disclosed is the turf with grass and a biodegradable, geotextile, porous foundation with the grass roots intertwining with the porous mat; the medium a mixture and the medium spread over the porous foundation. Buller, however, discloses a turf with grass ("turf" of page 1 2nd para.) and a biodegradable, geotextile, porous foundation ("hessian bonding mat" of page 1 2nd para.) with the grass roots intertwining with the porous mat ("grass roots through the peat mix and the hessian mat, and binds all together" of

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page 1 3rd para.); the medium a mixture (“mixture” from abstract) and the medium spread over the porous foundation (from “covering” from abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the turf of US 5,651,213 by adding a porous foundation with grass root intertwined as disclosed by Buller so as to have a turf that can be “rolled up and transplanted without the use of harvesters or the loss of top soil” (Buller at page 1 3rd para.).

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kuestner (US 2,605,589) in view of Beard (Turfgrass: Science and Culture) in further view of .

As to Claim 1, Kuestner discloses a transportable turf (col. 1 lines 11-17) comprising a porous foundation (12 of Figs. 1-3; “mesh’ of col. 2 lines 45-47); a soil-less sand (15 of Figs. 1-3) based root zone medium (14 and 15 of Figs. 1-3) comprising an organic amendment (“peat moss” of col. 2 line 23); grass having a root system (shown in Fig. 3), wherein the root system extends through the root zone medium and into the porous foundation and intertwines therewithin (“grass embedded in layer of mesh” of col. 1 lines 16-17) and the medium spread over the porous foundation (shown in Figs. 1 and 3). Not disclosed is the root zone medium with the sand at 60% by weight with a grain size of from 0.05 to 1mm and the medium a mixture.

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Beard, however, discloses using a soil component with at least 60% sand by weight ("soil mixture composed of 85-90% sand" of page 358) with a grain size of from 0.05 to 1 mm ("0.2 to 0.4 mm in diameter" of page 358) and a mixture (3rd para. of page 358), . It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the turf of Kuestner by using the sand composition of Beard so as to have a turf for areas of intense traffic ("used under intense traffic" of Beard at page 358) and making a mixture depending upon the specific type of medium required by the plant species.

As to Claim 2, Kuestner as modified by Beard further disclose an organic amendment (14 of Figs. 1-3 of Kuestner) in an amount less than about 40% by weight (from Beard at page 358, 3rd para.).

As to Claim 3, the limitations of Claim 1 are disclosed as described above. Kuestner as modified by Beard further disclose peat moss "peat moss" of col. 2 lines 20-27). Not disclosed is the peat moss being canadian sphagnum peat moss. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the turf of Kuestner as modified by Beard by using canadian sphagnum as the peat moss depending upon cost and availability of types peat moss.

As to Claim 4, Kuestner as modified by Beard further disclose the grains of sand having a uniform size from about 0.18 to 0.84 mm ("85 to 90% sand of 0.2 to 0.4 mm in diameter" of page 358 3rd para. of Beard).

As to Claim 5, Kuestner as modified by Beard further disclose a fertilizer (Beard at col. 2 lines 28-31).

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As to Claim 6, Kuestner as modified by Beard further disclose a geotextile ("plastic or other suitable material" of col. 2 lines 43-49 of Beard).

As to Claim 10, Kuestner as modified by Beard further disclose the porous foundation as not biodegradable (defining "plastic" as not biodegradable of col. 2 line 46 of Kuestner).

Claims 7, 8, and 11-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kuestner (US 2,605,589) in view of Beard (Turfgrass: Science and Culture) in further view of Zamboni (US 4,084,763).

As to Claim 7, the limitations of Claim 1 are disclosed as described above. Not disclosed is the porous foundation formed in a plurality of laterally disposed strips. Zamboni, however, discloses turf in a plurality of laterally disposed strips (col. 1 lines 10-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the turf of Kuestner as modified by Beard by making into strips as disclosed by Zamboni so as to used to cover playing fields (col. 1 lines 10-15) so as to increase use of the product.

As to Claim 8, Kuestner as modified by Beard and Zamboni further disclose the roots intertwining so as to bind the strips together (inherent in any turf strips layered next to one another since roots grow in many directions; see Zamboni at col. 1 lines 20-23).

As to Claim 11, Kuestner as modified by Beard and Zamboni further disclose the turf of sufficient length and width to cover a sports field with a single tract (Zamboni at col. 1 lines 10-23).

As to Claim 12, the limitations of Claim 1 are disclosed as described above. Not disclosed is the turf a single tract with a width of 40-45 feet. It would have been obvious to one

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of ordinary skill in the art at the time of the invention to further modify the turf of Kuestner as modified by Beard by making the strips into a single tract with a width of 40-45 feet as disclosed by Zamboni (col. 1 lines 10-23) so as to meet the particular purpose of covering a particular playing field.

As to Claim 13, the limitations of Claim 1 are disclosed as described above. Not disclosed is the turf a single tract with a width at least 3 times the width of the porous foundation. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the turf of Kuestner as modified by Beard by making the strips into a single tract with a width at least 3 times the width of the porous foundation as disclosed by Zamboni (col. 1 lines 10-23) so as to meet the particular purpose of covering a particular playing field.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kuestner (US 2,605,589) in view of Beard (Turfgrass: Science and Culture) in further view of Miyachi (US 4,982,526).

As to Claim 9, the limitations of Claim 1 are disclosed as described above. Not disclosed is the plastic being biodegradable. Miyachi, however, discloses the use of biodegradable plastic for a turf's porous foundation (col. 2 lines 39-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the turf of Kuestner as modified by Beard by making the porous foundation biodegradable as modified by Miyachi so as to make the turf more environmentally friendly.

Response to Arguments

Applicant's arguments filed 12 January 2005 have been fully considered but they are not persuasive. Applicant's arguments are: (1) Buller does not disclose motivation to modify any and every transportable turf to include a porous foundation and there is no showing in the office action that a turf prepared from a 4:1 peat/perlite mixture is applicable to turfs of other root zone mediums (Remarks page 6, 1st para.); and, (2) Kuestner does not disclose or suggest a root zone medium comprising a mixture of sand and an organic amendment (Remarks page 7, 2nd para.).

As to argument (1), Examiner considers Buller to disclose motivation to modify a any transportable turf by using a porous foundation so that the plants' "[r]oots remain undamaged and therefore transplant onto a new site very rapidly" (page 1, 2nd para.). Examiner considers the that the a porous foundation can be used with many, if not all, root zone media based on the basic biology of roots and soil physics. That is, the Examiner does not know a reason why any type of root zone media would not want a porous foundation when the goal is to transplant sod with undamaged roots. Transplanting without root damage is a common, known goal in horticulture.

As to argument (2), Beard discloses a mixture as the root zone medium as stated in the rejection above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Furumoto discloses in the prior art a turf with a porous foundation. Kajisawa and

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Fukase disclose in the art turf with foundations. Egan ('145 A1) is the instant application's pre-grant publication.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

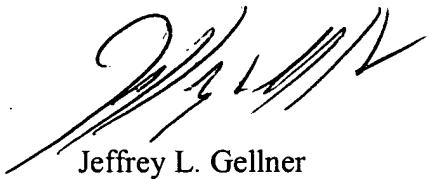
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 571.272.6887. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 571.272.6891. The official fax telephone number for the Technology Center where this application or proceeding is assigned is 703.872.9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

A handwritten signature in black ink, appearing to read 'J. Gellner', with a stylized flourish at the end.

Jeffrey L. Gellner
Primary Examiner